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Patent
Attorney's Docket No. 003510-092

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Ikuo KAWAUCHI

Application No.: 09/835,564

Filed: April 17, 2001

For: PLANOGRAPHIC PRINTING
PLATE PRECURSOR

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REQUEST FOR RECONSIDERATION

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the Official Action dated July 30, 2003, applicants respectfully request reconsideration in light of the discussion which follows.

In the Official Action, the Examiner raised a single of some of the claims, namely claims 11, 12, 15-17 and 20 under 35 U.S.C. §102(e) based on Shimazu et al., U.S. Patent No. 6,294,311.¹ The Examiner acknowledged that the claims recited a positive-type planographic printing plate precursor which include a defined photosensitive layer provided as a top layer while Shimazu et al. did not disclose such a layer. However, it was the Examiner's position that the underlayer of Shimazu et al. arguably met the recited top layer and if one stopped at this point, one would obtain the claimed "precursor".

¹ From the Office Action Summary and the indication of certain allowed claims on page 4 of the Action, it is presumed that the Examiner meant to include claim 17 in the rejection set forth on page 2 of the Action.

Applicants respectfully submit that the Examiner's interpretation of the subject matter defined in the rejected claims and the teachings of the prior art is in error. In each of the rejected claims, a positive-type printing plate precursor is recited with the defined top layer (rejected claims 16, 17 and 20 are method claims). The specification of the present application renders clear to one of ordinary skill in the art what is meant by a "printing plate precursor". For instance, in the opening paragraph of the application and in the first full paragraph of page 40 of the substitute specification, it is evident that the "printing plate precursor" is a material that is capable of being exposed and processed into a printing plate. This understanding is supported by the description below the formulas on page 46 of the substitute specification where the coating and drying of the photosensitive solution is disclosed so as "to obtain a planographic printing plate precursor of Example 1." These and other illustrative and comparative precursors are then subjected to exposure and development (see page 50, penultimate full paragraph).

Shimazu et al. does not disclose or suggest the various aspects of the present invention defined in the rejected claims. When the disclosed imageable layer is provided as an underlayer or first layer, it is not capable at that time of being exposed and processed into a printing plate. It is not until the separate top layer is provided on the underlayer that the "imageable element" of the patent is obtained. This understanding is abundantly clear from even the abstract which states that the imageable elements "contain a substrate, an underlayer, and a top layer." This is further evident from the passage at column 13, lines 7-8 which states: "The top layer of a photochemically imageable element comprises a positive working photoimagable [sic] composition." Furthermore, it will be noted from the

passage beginning at column 14, line 34 that imaging is only conducted with the complete imageable element that includes the distinct top layer of Shimazu et al.. The importance of the top layer is underscored by the passage beginning at column 15, line 26 which states in relevant parts:

Imaging of the imageable element produces an imaged element, which comprise a latent image of imaged and unimaged regions. Developing the exposed element to form a developed element, converts the latent image to an image by removing the exposed regions of the top layer and the underlayer, and exposing the hydrophilic surface of the underlying substrate.

The imageable element is "positive working," in that the first and top layers are removed in the exposed regions to expose the underlying hydrophilic surface of the hydrophilic substrate. Thus, the exposed regions become the non-ink accepting regions.

The exposed element is developed in an appropriate developer. The developer may be any liquid or solution that can penetrate and dissolve both the exposed regions of the top layer and the underlying regions of the underlayer without substantially affecting the complimentary unexposed regions.

* * *

The developed element, typically a lithographic printing member or printing plate, comprises (1) regions in which the underlayer and top layer have been removed revealing the underlying surface of the hydrophilic substrate, and (2) complimentary regions in which the under layer and top layer have not been removed. The regions in which both the underlayer and top layer have not been removed are ink receptive and correspond to the regions that were not exposed during imaging.

From this description it is evident that the top layer is crucial to the ability of the disclosed imageable element to be exposed and subsequently transformed into a printing plate. Without the top layer, there would be no ink-receptive layer and consequently no

ability to function as a printing plate.² Thus, not only does Shimazu et al. completely fail to anticipate the rejected claims, it would certainly not be obvious to eliminate the required top layer (even assuming that there was some teaching in the art to do so), particularly in view of decisions which hold that references cannot be properly combined if the effect would be to destroy the invention on which one of the reference patents is based.³

With a proper understanding of the claims in the present application and the fair teachings of the patent, applicants respectfully maintain that the rejected claims, as well as those previously found allowable, are patentable in all regards and therefore respectfully request reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, she is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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² Column 7, lines 45-46 describe the top layer as being ink receptive.

³ See, e.g., Ex parte Hartmann, 186 USPQ 366 (Bd. App. 1974).